REMARKS

Applicants respectfully request that the above-identified application be re-examined.

Initially, applicants note that the Office Action mailed August 25, 2006 (hereinafter "Office Action"), fails to acknowledge an IDS filed with the U.S. Patent and Trademark Office on November 21, 2003, and a supplemental IDS filed with the U.S. Patent and Trademark Office on December 5, 2003. Applicants request that both IDSs be acknowledged in the next Official Action.

The Office Action rejected Claims 1-9 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Remarks accompanying this rejection state that Claims 1-9 are directed to application programming interface, which is software *per se* and therefore neither a process, machine, manufacture nor composition of matter. In response, applicants have canceled the aforementioned claims and added new claims (Claims 20-25). The new claims (Claims 20-25) are directed to an integrated address book clearinghouse interface stored on a computer-readable storage medium, and are thus submitted to be statutory. Accordingly, applicants submit that the 35 U.S.C. § 101 rejection of Claims 1-9 has been rendered moot.

The Office Action also rejected Claims 1, 3-7, 11-13, and 15 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicants regard as the invention. In response, applicants have canceled the aforementioned claims. Accordingly, the aforementioned rejection of Claims 1, 3-7, 11-13, and 15 has also been rendered moot.

The Office Action rejected Claims 1, 3, 4, 8-13, 18, and 19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,835,089, issued to Skarbo et al. (hereinafter "Skarbo") in view of U.S. Patent No. 6,370,566, issued to Discolo et al. (hereinafter "Discolo"). The Office Action further rejected Claims 2, 5-7, and 14-17 under 35 U.S.C. § 103(a) as being unpatentable over Skarbo in view of Discolo as applied to Claim 1 and further in view of U.S. Patent

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No. 7,092,945, issued to Hall et al. (hereinafter "Hall"). In response, applicants have canceled the aforementioned claims and added new claims (Claims 20-39). Applicants respectfully submit that the new claims (Claims 20-39) are clearly patentably distinct from Skarbo, Discolo, and Hall because Skarbo, Discolo, and Hall do not teach, suggest, or describe all claim limitations of the new claims, which are discussed in detail hereinafter.

Prior to discussing in detail why applicants believe that all of the claims in the present application are allowable in view of the cited and applied references, a brief description of the disclosed subject matter and a brief description of the teachings of the cited and applied references are provided. The following discussions of the disclosed subject matter and the cited and applied references are not provided to define the scope or interpretation of any of the claims of this application. Instead, these discussions are provided to help the United States Patent and Trademark Office better appreciate important claim distinctions discussed thereafter.

<u>Disclosed Subject Matter</u>

An interface, system, and a computer-implemented method for managing a plurality of address books that form an integrated address book clearinghouse are disclosed. According to one exemplary aspect, the interface comprises a plurality of function modules that are used by a plurality of application programs for managing the plurality of address books that form the integrated address book clearinghouse by performing functions on the integrated address book clearinghouse. The interface also comprises an encapsulation module for encapsulating, in a data envelope, requests for the performance of a function on the integrated address book clearinghouse and an authorization to perform the requested function. The application program interface further comprises an analyzing module for analyzing data envelopes to detect requests to perform functions on the integrated address book clearinghouse and authorization to perform the requested functions, an address book function call module for generating function calls requesting the performance of functions on the integrated address book clearinghouse if such

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requests are authorized, a function call processing module for processing function calls requesting the performance of functions on the integrated address book clearinghouse, a function call response module for generating responses to process function calls, and a response encapsulation module for encapsulating, in a data envelope, a response to process a function call and information that identifies an address book of the plurality of address books on which a function call was carried out.

According to another exemplary aspect, the system comprises a plurality of clients, each client including at least one application program capable of accessing the plurality of functions associated with the at least one application. The at least one application program is also capable of generating a request to perform a function on the integrated address book clearinghouse and authorization to perform the request. The system further comprises a server arrangement for storing the integrated address book clearinghouse, receiving requests from the plurality of clients to perform functions on the integrated address book clearinghouse, examining received requests to perform functions on the integrated address book clearinghouse to determine if the requests also include authorization to perform the requests, performing the function if a received request includes authorization to perform the function on the integrated address book clearinghouse, and reporting the performance of the function to the client that generated the request to perform the function on the integrated address book clearinghouse, the reporting including information identifying a user controlled address book of the plurality of user controlled address books on which the function was performed.

According to yet another exemplary aspect, the method for managing the integrated address book clearinghouse comprises generating a request to perform a function on the integrated address book clearinghouse, the function comprising one of a plurality of functions usable by the plurality of application programs. The method further comprises determining if the request to perform the function also includes authorization to perform the request, performing the

requested function if the request includes authorization, generating a response to the request after the request is performed, the response including information identifying an address book of the plurality of address books on which the requested function was performed, and sending the response to the source of the request.

Skarbo - U.S. Patent No. 5,835,089

Skarbo purportedly discloses an application program interface for sharing services of an address book in a computer system. The application program interface provides a register function call, which enables a set of client communication application programs executing on the computer system to each register a callback function. The application program interface also provides a notify function call that enables an address book application program executing on the computer system to notify the appropriate client communication application program via the appropriate callback function when a user has selected a destination identifier for the corresponding communication type. Skarbo does not disclose that the application program interface can share services of more than one address book in the computer system.

Discolo - U.S. Patent No. 6,370,566

Discolo purportedly discloses a mobile device that provides a user with the ability to schedule a meeting request from the mobile device itself. The mobile device creates an object representative of the meeting request and assigns the object a global identification number, which uniquely identifies the object to other devices that encounter the object. In addition, the mobile device provides a property in the object that is indicative of whether the meeting request has already been transmitted. In this way, other mobile devices that encounter the meeting request are capable of identifying it as a unique meeting request and of determining whether the meeting request has already been transmitted. This alleviates the problem of duplicate meeting request transmissions. Discolo does not disclose that the mobile device of the user that creates the object is capable of creating an object for other mobile devices.

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<u>Hall - U.S. Patent No. 7,092,945</u>

Hall purportedly discloses a method and system for facilitating the retrieval of data from a database using a communications device where the database is stored remotely from the communications device. A communications device may obtain remote data, such as e-mail addresses, facsimile numbers, phone numbers, or uniform resource locators, from a user's remotely stored personal database. Hall does not disclose that the personal database stores remote data of more than one user.

<u>Argument</u>

<u>New Independent Claim 20, 26, 34</u>

New Independent Claims 20, 26, and 34 read as follows:

> 20. An integrated address book clearinghouse interface stored on computer-readable storage medium, the integrated address book clearinghouse interface comprising:
> a plurality of function modules, usable by a plurality of application programs for managing a plurality of address books that form an integrated address book clearinghouse, by performing functions on the integrated address book clearinghouse;
> an encapsulation module for encapsulating in data envelopes requests for the performance of functions on the integrated address book clearinghouse and authorization to perform the requested functions;
> an analyzing module for analyzing data envelopes to detect requests to perform functions on the integrated address book clearinghouse and authorization to perform such requested functions;
> an address book function call module for generating function calls requesting the performance of functions on the integrated address book clearinghouse if such requested functions are authorized;
> a function call processing module for processing function calls requesting the performance of functions on the integrated address book clearinghouse;
> a function call response module for generating responses to processed function calls; and
> a response encapsulation module for encapsulating in data envelopes responses to processed function calls and information identifying an address book of the plurality of address books on which a function call was carried out.

26.   A computer-implemented method for managing an integrated address book clearinghouse comprising:

generating a request to perform a function on the integrated address book clearinghouse, the function comprising one of a plurality of functions usable by a plurality of application programs for managing the integrated address book clearinghouse, the integrated address book clearinghouse comprising a plurality of address books;

determining if the request to perform the function on the integrated address book clearinghouse also includes authorization to perform the request;

performing the requested function on the integrated address book clearinghouse if the request includes the authorization to perform the request;

generating a response to the request after the request is performed, the response including information that identifies the address book of the plurality of address books on which the requested function was performed; and

sending the response to the source of the request.

34.   A computer system comprising:

(a)   a plurality of clients, each of the clients including at least one application program capable of:

(i)   accessing a plurality of functions associated with the at least one application, the plurality of functions managing a plurality of user controlled address books, the plurality of user controlled address books forming an integrated address book clearinghouse; and

(ii)   generating a request to perform a function on the integrated address book clearinghouse and authorization to perform the request; and

(b)   a server arrangement for:

(i)   storing the integrated address book clearinghouse;

(ii)   receiving requests from the plurality of clients to perform functions on the integrated address book clearinghouse;

(iii)   examining received requests to perform functions on the integrated address book clearinghouse to determine if the requests also include authorization to perform the requests;

(iv)   performing a function if a received request includes authorization to perform the function on the integrated address book clearinghouse; and

(v)   reporting the performance of the function to the client that generated the request to perform the function on the integrated address book clearinghouse, the reporting including information

identifying a user controlled address book of the plurality of user controlled address books on which the function was performed.

Applicants agree with the Office Action remarks that Skarbo is silent with reference to "a response encapsulation module for encapsulating in data envelopes responses to processed function calls and information identifying an address book of the plurality of address books on which a function call was carried out," recited in Claim 20, "generating a response to the request after the request is performed, the response including information that identifies the address book of the plurality of address books on which the requested function was performed," recited in Claim 26, and "reporting the performance of the function to the client that generated the request to perform the function on the integrated address book clearinghouse, the reporting including information identifying a user controlled address book of the plurality of user controlled address books on which the function was performed," recited in Claim 34.

Further, applicants submit that Skarbo does not explicitly teach "a plurality of function modules, usable by a plurality of application programs for managing *a plurality of address books that form an integrated address book clearinghouse*" (emphasis added), recited in Claim 20, "generating a request to perform a function on the integrated address book clearinghouse, the function comprising one of a plurality of functions usable by a plurality of application programs for managing the integrated address book clearinghouse, the integrated address book clearinghouse comprising *a plurality of address books*" (emphasis added), recited in Claim 26, and "accessing a plurality of functions associated with the at least one application, the plurality of functions managing a plurality of user controlled address books, *the plurality of user controlled address books* forming an integrated address book clearinghouse" (emphasis added), recited in Claim 34. In this regard, Col. 8, lines 48-50, of Skarbo state: "At block 220, the user selects an address book entry in **the** address book 50 via the keyboard and mouse 28" (emphasis added.)

The above section shows that Skarbo is clearly directed to only one address book, not a plurality of address books from which a user selects an address book entry.

Furthermore, applicants submit that Discolo does not explicitly teach "a plurality of function modules, usable by a plurality of application programs for *managing a plurality of address books* that form an integrated address book clearinghouse, by performing functions on the integrated address book clearinghouse" (emphasis added), recited in Claim 20, "generating a request to perform a function on the integrated address book clearinghouse, the function comprising one of a plurality of functions usable by a plurality of application programs for *managing the integrated address book clearinghouse, the integrated address book clearinghouse comprising a plurality of address books*" (emphasis added), recited in Claim 26, and "accessing a plurality of functions associated with the at least one application, the plurality of functions *managing a plurality of user controlled address books*, the plurality of user controlled address books forming an integrated address book clearinghouse" (emphasis added), recited in Claim 34. Discolo explicitly teaches that the plurality of functions manage **a** mobile device and not **a mobile device in a plurality of mobile devices**. Col. 9, lines 43-44, of Discolo state: "The response is addressed to the meeting originator, or another proper delegate. Accordingly, the response encapsulated in the response data envelope is not associated with information identifying a mobile device in a plurality of mobile devices."

Since Skarbo fails to teach "a plurality of function modules, usable by a plurality of application programs for managing a plurality of address books that form an integrated address book clearinghouse, by performing functions on the integrated address book clearinghouse," recited in Claim 20, "generating a request to perform a function on the integrated address book clearinghouse, the function comprising one of a plurality of functions usable by a plurality of application programs for managing the integrated address book clearinghouse, the integrated address book clearinghouse comprising a plurality of address books," recited in Claim 26, and

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"accessing a plurality of functions associated with the at least one application, the plurality of functions managing a plurality of user controlled address books, the plurality of user controlled address books forming an integrated address book clearinghouse," recited in Claim 34, and Discolo fails to teach "a response encapsulation module for encapsulating in data envelopes responses to processed function calls and information identifying an address book of the plurality of address books on which a function call was carried out," recited in Claim 20, "generating a response to the request after the request is performed, the response including information that identifies the address book of the plurality of address books on which the requested function was performed," recited in Claim 26, and "reporting the performance of the function to the client that generated the request to perform the function on the integrated address book clearinghouse, the reporting including information identifying a user controlled address book of the plurality of user controlled address books on which the function was performed," recited in Claim 34, applicants submit that whether or not Skarbo and Discolo are properly combined, Skarbo and Discolo do not teach, suggest, or describe, alone or in combination, the foregoing recitations of Claims 20, 26, and 34. Nor does Hall teach this subject matter. In this regard, a *prima facie* case of obviousness under 35 U.S.C. § 103(a) can be established only if the cited references, alone or in combination, teach each and every element recited in the claim. *In re Bell*, 991 F2d 781 (Fed. Cir. 1993). As shown above, Skarbo and Discolo do not teach, suggest, or describe, alone or in combination, all foregoing recitations of Claims 20, 26, and 34. Nor does Hall describe the missing subject matter.

Applicants further submit that contrary to the statements set forth in the Office Action, it would not be obvious to combine the teachings of Skarbo and Discolo, and/or Hall. In this regard, the Office Action has again failed to establish a *prima facie* case of obviousness. There is no teaching or suggestion in Skarbo or Discolo, and/or Hall to modify the references or combine their teachings. Nor is there any basis for concluding that they could be combined.

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None of the references suggest the combination, and applicants submit that there is no basis for concluding that it would be obvious to combine the teachings of these references in any manner, much less in the manner recited in Claims 20, 26, and 34. Further, even if combinable, which applicants categorically deny, the resultant combination, as set forth above, would not meet the recitations of Claim 20, 26, and 34. At most, the resultant combination would include a Skarbo interface comprising a response generating module of Discolo for generating a response from one of the plurality of address book management functions that manage an address book. This combination would not meet the recitation of Claims 20, 26, and 34 described above. Accordingly, applicants submit that Claims 20, 26, and 34 are allowable in view of the teachings of Skarbo and Discolo, and/or Hall taken alone or in combination.

New Dependent Claims 21-25

Claims 21-25 depend directly or indirectly from independent Claim 20, and include all of the recitations of the base claim. Accordingly, Claims 21-25 are submitted to be allowable for at least the same reason that Claim 20 is allowable. In addition, Claims 21-25 further add to the patentability of applicants' invention. Accordingly, applicants request that Claims 21-25 be allowed.

New Dependent Claims 27-33

Claims 27-33 depend directly or indirectly from independent Claim 26, and include all of the recitations of the base claim. Accordingly, Claims 27-33 are submitted to be allowable for at least the same reason that Claim 26 is allowable. In addition, Claims 27-33 further add to the patentability of applicants' invention. Accordingly, applicants request that Claims 27-33 be allowed.

New Dependent Claims 35-39

Claims 35-39 depend directly or indirectly from independent Claim 34, and include all of the recitations of the base claim. Accordingly, Claims 35-39 are submitted to be allowable for at

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least the same reason that Claim 34 is allowable. In addition, Claims 35-39 further add to the patentability of applicants' invention. Accordingly, applicants request that Claims 35-39 be allowed.

<div align="center">CONCLUSION</div>

In view of the foregoing remarks, applicants respectfully submit that the above-identified application is in condition for allowance. Re-consideration and re-examination of the application, and allowance of the new claims (Claims 20-39) at an early date are solicited. If the Examiner has any questions or comments concerning this matter, the Examiner is invited to contact the undersigned at the number provided below.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first-class mail with postage thereon fully prepaid and addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the below date.

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